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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,303	03/14/2001	Yoshihito Ishibashi	09792909-4859	3750

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EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,303

Applicant(s)

ISHIBASHI, YOSHIHITO

Examiner

Marissa Thein

Art Unit

3627

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 19-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on August 12, 2004 is acknowledged.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

The drawings filed on March 15, 2001 are acceptable.

***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-18 are rejected under 35 U.S.C. 101 because it fails to recite computer executable instructions. The claims are directed to "a program providing medium". Giving the term its broadest reasonable interpretation, the claims are directed to a program per-se and a program instruction. Accordingly, the claim fails to recite a

Art Unit: 3627

positive functional interrelationship between the medium and the activities recited.

Please refer to MPEP 2106.

For example claim 17, can be rewritten as “a computer-readable medium having stored therein computer-executable instructions..... for performing the steps of.....”.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims do not recite action method steps.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,389,538 to Gruse et al.**

Regarding claims 1, Gruse discloses a content secondary distribution management system comprising: a plurality of user devices for managing secondary

Art Unit: 3627

distribution in which a transaction of content usable by a user device is performed between the plurality of user devices (col. 11, lines 49-64; col. 13, lines 5-9; Figure 6), wherein a settlement log (audit logs and tracking col. 47, lines 49-55; col. 13, line 45 – col. 14, line 9) for the use of the content is issued from a content providing user (content provider) device to one of a service provider (electronic store) and a clearing center (clearinghouse) every time an identical content is distributed (see at least col. 21, lines 46-51; col. 47, lines 49-55) and a settlement processing for the identical content is performed under the management of the one of a service provider and clearing center (see at least col. 23, lines 19-38).

Regarding claim 2, Gruse discloses a content receiving user (end user) device for receiving the content deducts a content usage fee from an electronic money balance up to an allowable amount of money set in an issue log based on information of usage control policy of the content, the content receiving user device creates a usage log; the content providing user device creates a receive log and sends the receive log to the service provider and a clearing center; and the service provider and the clearing center performs the settlement processing for the electronic money for the use of the content based on the receive log, and requests and account management institution to perform transfer processing for the content usage fee; and the account management institution performs the transfer processing (see at least col. 48, lines 1-43; col. 49, lines 31-61).

Regarding claims 3-8 and 10-16, Gruse discloses:

- the content to be distributed between the user devices is contained in a secure container which stores a content price and information of a usage control policy

including profit distribution information (see at least col. 10, lines 9-17), and wherein the service provider and a clearing center constructs a form of the transfer processing according to a log containing a content fee payer and a content fee receiver based on the profit distribution information (see at least col. 11, lines 2-9; col. 15, lines 18-25);

- the usage control policy information includes indicating whether the secondary distribution of the content between the user devices is allowed, and wherein upon receiving the receive log created for a content in which the secondary distribution is not allowed, the service provider and the clearing center nullifies settlement processing to be performed for the receive log (see at least col. 23, lines 19-38);
- each user devices for performing the transaction of the content comprises an encryption processing unit, mutual authentication processing, and the user devices attach a digital signature and verify the digital signature (see at least col. col. 9, lines 58-67; col. 10, lines 4-17; col. 12, lines 43-54; col. 15, lines 30-35; col. 16, lines 42-55; col. 17, lines 12-20);
- the user devices, service provider, and clearing center comprises an encryption processing unit, mutual authentication processing, attach a digital signature and verify the digital signature (see at least col. col. 9, lines 58-67; col. 10, lines 4-17; col. 12, lines 43-54; col. 15, lines 30-35; col. 16, lines 42-55; col. 17, lines 12-20);
- the clearing center comprises a user balance database for managing an electronic money balance of the content and creates an issue log in which an

Art Unit: 3627

allowable amount of money is set up to electronic money balance (see at least col. 47, lines 49-67; col. 48, lines 1-43); and

- usage control policy information includes profit distribution information of the content usage fee, and where usage log and receive log include the profit distribution information, the service provider and clearing center performs the settlement processing for the content usage fee based on profit distribution information also sends the transfer request to the account management institution (see at least col. 10, lines 9-17; col. 11, lines 2-9; col. 15, lines 18-25).

Regarding claims 9, and 17-18, Gruse discloses a method and program providing medium for managing secondary distribution in which a transaction of content usable a user device is performed between a plurality for user devices (col. 11, lines 49-64; col. 13, lines 5-9; Figure 6), comprising: issuing a settlement log for the use of the content from a content providing user device to a service provider and a clearing center every time an identical content is distributed; and performing settlement processing for the identical content based on the settlement log under the management of the service provider and a clearing center (see at least col. 47, lines 49-55; col. 13, line 45 – col. 14, line 9; col. 21, lines 46-51; col. 23, lines 19-38).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,226,618 to Downs et al. discloses electronic content delivery system.

Art Unit: 3627

U.S. Patent No. 6,389,403 to Dorak, Jr. discloses a method and apparatus for identifying a customer purchase in an electronic distribution system.

U.S. Patent No. 6,418,421 to Hurtado et al. discloses multimedia player for an electronic content delivery system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
October 31, 2004

*Michael Cuff* 11/1/04  
**MICHAEL CUFF**  
**PRIMARY EXAMINER**